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EXAMINER

ART UNIT PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 09/385,394	Applicant(s) YATES ET AL.	
	Examiner Richard Ellis	Art Unit 2183	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 01 December 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☒ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☒ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☒ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☒ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☒ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☒ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☒ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

See attached four sheets numbered two through five which contain detailed explanations of the above defects.



**RICHARD L. ELLIS
PRIMARY EXAMINER**

Explanation regarding box 1

37 CFR § 41.37 (c)(1) states:

The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of the section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

In the present brief, applicant has omitted section (vi) and (x) from the brief, and has placed section (v) under an incorrect heading.

Note that regarding section (c)(1)(v), the rule requires a "Summary of claimed subject matter" while applicant's brief provides a section labeled "Informal Summary of the Subject Matter".

Note that regarding section (c)(1)(x), MPEP § 1205.02 states in pertinent part:

(x) *Related proceedings appendix.* ... If there are no such copies of decisions being submitted in the appeal, then a related proceedings appendix should be included with the indication "none."

Applicant's brief contains no section (x), while MPEP § 1205.02 states that a section (x) should be included with the indication "none".

Explanation regarding box 2

37 CFR § 41.37 (c)(1)(iii) states:

Status of claims. A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

Applicant's status of claims section does not identify "the status of all the claims". The section fails to identify canceled, withdrawn, and objected to claims (i.e., no status is provided for claims 1-21, 37-50, 61-62 and 113-133). Additionally, the status of claims 22-36, 51-60, 63-112, and 134-141 is mis-identified as "not allowed but not rejected".

Additionally the section does not provide "an identification of those claims that are being appealed".

Explanation regarding box 3

37 CFR § 41.37 (c)(1)(iv) states:

Status of amendments. A statement of the status of any amendments filed subsequent to final rejection.

Although applicant provides a section (iv), applicant's section (iv) incorrectly identifies an after final amendment as entered when in fact it was denied entry in an advisory action mailed June 7, 2005.

Explanation regarding box 4

37 CFR § 41.37 (c)(1)(v) states:

Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Applicant's summary section is labeled "Informal Summary of the Subject Matter" and it is just that, **informal**. Some of the reasons for why the summary fails to meet the requirements of 37 CFR § 41.37(c)(1)(v) are outlined below:

1. It fails to provide a "concise explanation of the subject matter defined in each of the independent claims". In fact, it makes no reference to any claim, must less to each independent claim. Note that 37 CFR § 41.37 requires that "the subject matter defined in each ... independent claim" be summarized. This requires a summary for each independent claim, not a single summary that refers to all independent claims simultaneously.
2. It fails to "refer to the specification by page and line number". In fact, in only one instance does applicant refer to the specification by page and line number. In all other instances, applicant merely refers to a page of the specification. This does not meet the requirements of MPEP § 1205.02 which states:

While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application.

3. It fails to "refer ... to the drawing, if any, by reference characters". In some instances applicant refers to reference characters, but in most instances applicant refers only to a figure, not to a reference character. For example, on the first line of pg. 5 applicant refers to plural figures, and from this list, just figs. 1a and 1c alone contain numerous reference characters. This does not allow "the Board to more quickly determine

where the claimed subject matter is described" as stated in MPEP § 1205.02 (see citation above).

Explanation regarding box 5

37 CFR § 41.37(c)(1)(vi) states:

Grounds of rejection to be reviewed on appeal. A concise statement of each ground of rejection presented for review.

Applicant's brief contains no section that provides a concise statement of each ground of rejection presented for review as required by 37 CFR § 41.37(c)(1)(vi).

Explanation regarding box 6

37 CFR § 41.37(c)(1)(vii) states in part:

Argument. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, ... Each ground of rejection must be treated under a separate heading. ...

Because applicant's brief fails to provide a section (c)(1)(vi) as explained above, it also fails to provide a separate heading for each ground of rejection submitted for review.

Explanation regarding box 7

37 CFR § 41.37(c)(1)(viii) states:

Claims appendix. An appendix containing a copy of the claims involved in the appeal.

Applicant's claims appendix fails to meet the requirements of 37 CFR § 41.37(c)(1)(viii) for at least the following two reasons:

1. It contains claims that were denied entry in the advisory action mailed June 7, 2005.
2. It contains copies of claims that are not "involved in the appeal" because they have been indicated as allowable, but does not annotate all claims with their appeal status (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled, or appealed) in order to facilitate the Board's review of the claims. E.g., claim 2 is annotated as "original" when it's proper status for the appeal is "allowed".

Explanation regarding box 8

37 CFR § 41.37(c)(1)(ix) states:

Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered

evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

Applicant's evidence appendix fails to include "a statement setting forth where in the record that evidence was entered in the record by the examiner". Note that section (ix) of 37 CFR § 41.37 requires that this statement be part of the evidence appendix: "An appendix containing copies ... along with a statement ..."

Explanation regarding box 9

MPEP § 1205.02 states in pertinent part:

... (ix) *Evidence appendix*. ... If there is no evidence being relied upon by appellant in the appeal, then an evidence appendix should be included with the indication "none." ...

Applicant's brief fails to provide an evidence appendix with the indication "none" as stated by MPEP § 1205.02.

Note: The office notes that the majority of the pages of applicant's brief contain statements and arguments directed to issues which are not subject to appeal. Although the office can not require applicant to strike these items from the brief, applicant is informed that items within the brief that are not subject to appeal will not be commented upon in any forthcoming examiner's answer.